



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,499	06/25/1999	JOHN S. HENDRICKS	026880.00014	9133

4372 7590 02/08/2008
ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER

KNEPPER, DAVID D

ART UNIT	PAPER NUMBER
----------	--------------

2626

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

02/08/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

<div style="border: 1px solid black; width: 150px; height: 20px; margin: 0 auto;"></div> <p style="text-align: center;">Office Action Summary</p>	Application No.	Applicant(s)	
	09/344,499	HENDRICKS ET AL.	
	Examiner	Art Unit	
	David D. Knepper	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 is/are pending in the application.
 4a) Of the above claim(s) 14-21, 35-42 and 55-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4 sheets</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's correspondence and IDS filed on 1 Aug 2007 and 17 Jan 2008 has been received and considered. However, the IDS filed on 1 Aug 2007 repeats a large number of previously considered documents to include documents cited by the Examiner. In particular, the definition of "word processor" showing a common interpretation of this terminology was repeated which implies that the applicant did not fully consider the comments and/or the earlier citation of this document. The applicant's further arguments indicate that the applicant is not familiar with this type of technology.

2. Claims 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 are pending. Claims 7 and 28 have been canceled. Claims 14-21, 35-42 and 55-58 are withdrawn. The previous restriction requirement is repeated below and election stands as noted below.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-13, 22-34, 43-54, 59-62 drawn to Text to Speech, classified in class 704, subclass 260.

II. Claims 18, 19, 39, 40, 55-58 drawn to Speech to Text, classified in class 704, subclass 235.

III. Claims 20, 21, 41, 42 drawn to Security Access, classified in class 704, subclass 273.

IV. Claims 14-17 and 35-38, drawn to Speech Controlled Systems, classified in class 704, subclass 275.

4. This requirement is FINAL as previously noted in June 2006.

5. Claims 18-21, 35-42 and 55-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4 November 2004.

6. This application contains claims 18-21, 35-42 and 55-58 drawn to inventions nonelected without traverse in the Paper of 4 November 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

7. Applicant's election without traverse of invention I (as corrected above) is acknowledged. The applicant has withdrawn claims 14-21 and 55-58 in the response dated 30 October 2006 but has not properly responded to the restriction as required.

Claims

8. Claims 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant's argument "that the input could not come from 'pages' of an 'electronic book' because a word processor is capable of displaying text in a page format" is evidence of improper hindsight indicates that word processor software designed to allow computer users to input and format books cannot be used in spite of the common definition from the Computer

Dictionary provided which teaches that word processor software could be used to create electronic books. Word processor software is the most common method to create electronic books but the applicant has provided evidence in their arguments that books created using such well known combinations of apparatus and methods (i.e. – computers and software) cannot be used to implement the instant invention. However, the specification fails to provide details to make and use the claimed invention without using a word processor or other known combinations of computers and software. In other words, the applicant must teach how to make and use an “electronic book” that is significantly different than the prior art text documents that one of ordinary skill in the art would know as electronic book representations created by computer software such as word processors, spreadsheets, etc. that could be displayed or printed in page formats.

The applicant's arguments of 14 Sep 2007 repeat the false accusation of improper hindsight without any support and only mention the use of a word processor while suggesting that the claims do not require the use of a word processor. However, the claims perform functions such as displaying pages from a book that are commonly performed by a word processor commonly implemented by software on a computer. Thus, the applicant's argument that the claimed function cannot be performed by a word processor as taught by the prior art is false. Therefore, the applicant should withdraw and apologize for the false accusation of hindsight or must provide reasonable support for the argument. The problem with the applicant's argument is that it contradicts the teachings of the specification and the prior art. Therefore, the rejection under 35 USC 112, first paragraph is necessary because the most common implementation of the claimed functions which, under ordinary circumstances would be

otherwise considered obvious to one of ordinary skill in the art, cannot be considered supported by such teachings as long as contradictory arguments made by the applicant remain.

In addition to supplying teachings in the specification as noted above, the applicant should also use claim terminology that could not be broadly interpreted to read upon computers and/or computer software capable of performing functions to create electronic books.

9. Claims 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant's argument "that the input could not come from 'pages' of an 'electronic book' because a word processor is capable of displaying text in a page format" is evidence of improper hindsight indicates that word processor software designed to allow computer users to input and format books cannot be used in spite of the common definition from the Computer Dictionary provided which teaches that word processor software could be used to create electronic books. Word processor software is the most common method to create electronic books but the applicant has provided evidence in their arguments that books created using such well known combinations of apparatus and methods (i.e. – computers and software) cannot be used to implement the instant invention. However, this argument is confusing because the specification fails to provide details to make and use the claimed invention without using a word processor or other known combinations of computers and software. In other words, this causes confusion in determining how the applicant will make and use an "electronic book" that is different than prior art text documents that one of ordinary skill in the art would know as

electronic book representations created by computer software such as word processors, spreadsheets, etc. that could be displayed or printed in page formats.

It is also noted that the specification on page 8 indicates that “‘book’ means textual or graphical information such as contained in any novels, encyclopedias, articles, magazines or manuals.” This would require a broad interpretation which would read on word processors, contradicts the applicant’s arguments and makes it difficult to figure out how the applicant intends the claims to define the invention.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-6, 8-13, 22-27, 29-34 and 43-46, 49, 51-54 and 59-62 are rejected under 35 U.S.C. § 103 as being unpatentable over Holm (5,850,629) in view of Simpson (“Mastering WORDPERFECT® 5.1 & 5.2 for Windows”) and Dictionary (Microsoft Press Computer Dictionary, Second Edition, 1994).

As per claims 1, 22, 43, 51: “providing text-to-audio conversion” is taught by Holm’s text-to-speech (title):

“selecting an electronic book for viewing from a list of available books stored in a operations center” (suggested by Holm in col. 10, lines 29-32 where he indicates that an entire text, such as a book, could be loaded into the local buffer. See also, pages 416-419 of Mastering WORDPERFECT® for various examples of how lists may be displayed. Thus, it would have

been obvious to select a document such as a book from a list of books as well as words or paragraphs from longer texts. The language “stored in an operations center” is obvious because the prior art teaches that text-to-speech ...may be implemented on a range of different operating system platforms, col. 2, lines 64-67, which would allow the invention to be performed at any location capable of containing a computer. Furthermore, the location of the computer and any storage medium in an operations center would fail to cause the computer or storage to act any differently if it was in another location such as a library, school, home, office, etc... therefore, it would be obvious that such computer systems could be in a large variety of locations);

“displaying a page of an electronic book” (suggested by his display in Figs. 1 and 3 which show windows containing WORDPERFECT® (word processing, col. 3) and Microsoft Excel (spreadsheet, col. 4) documents – it is common knowledge that these allow a user to define page attributes and other word processing functions designed to provide the publishing industry flexibility to manipulate text in a wide variety of common book formats – see column 3, lines 15-17 which states: Fig. 1 depicts a Windows 30 environment containing a word processing target application 32 indicating that it would be obvious to use any known word processor and therefore, any book format that a word processor is capable of supporting);

“receiving a selection of text on the displayed page for conversion to speech” (his teaching that the user selects text in the open text window 34, col. 3, lines 26-27); and

“converting at least a portion of the selected text into the corresponding speech” (his teaching that the conversion of the highlighted text 44 begins once the play button 46... is activated). [Note: for claim 43, the highlighted text portion teaches the claimed “displaying a section” because this displays the selected or identified text.]

It is noted that Holm does not explicitly use the terms “page” or “electronic book”. However, he teaches that it is obvious to receive text that includes books as noted above and he explicitly teaches any application that can display text data in a window format by using examples such as word processors and spreadsheets as also noted above. It would have been obvious for a person having ordinary skill in the pertinent art, at the time the invention was made, that the input could come from “pages” of an “electronic book” because a word processor is capable of displaying text in a page format (see Simpson who shows that WORDPERFECT® is capable of displaying a variety of page formats on pages 73-74). The argument from page 5 of 14 sep 2007 that the prior art does not teach selection “from a list” is addressed with pages 416-419 of Mastering WORDPERFECT® showing examples of lists displayed on a computer which allow a user to select from a list of documents.

The applicant’s arguments of 7 Nov 2005 on pages 21-23 that the motivation statement is based on hindsight has no basis in fact because the prior art clearly shows text to speech conversion in combination with a word processor is well known in the art. As further evidence, the Examiner has provided a definition of word processor that shows that this term alone would have been known to one of ordinary skill in the art as of 1994 to include complex computer programs capable of manipulating a variety of text-based documents to include at least limited facilities for document formatting, such as font changes, page layout, paragraph indentation, and the like...

Claims 2, 3: Pausing and resuming is taught with the transport, figure 3a.

Claim 4, 25, 44, 52: Providing a definition is taught with his Dictionary, fig. 4.

Claim 5, 26, 49: Adjusting rate is taught by his speed lever 92, figure 4.

Claim 6, 27: Type of voice is taught by his gender selection 84, and frequency lever 94, figure 4.

Claims 32, 60, 62: See claim 1 above. The production of audio by selecting an audio file related to the text is an obvious application of well known concatenation techniques taught by Holm as known prior art in column 1. His teaching is to improve upon this basic technique and he teaches that his improved audio files are normally stored on the computer hard disk and may be concatenated and played in real time (col. 6, lines 63-65).

Claims 8, 11, 29: See claim 1 above. Simpson shows that it is notoriously well known to display pages of text and Holm clearly teaches that his improvement will allow the user a variety of methods for selecting any desired portion of text for conversion to speech. This teaches that it is well known to prepare text data in a variety of formats which will allow pages to be displayed as selected individually or in sequence.

Claims 9, 10, 12, 13, 23, 24, 30, 31, 33, 34, 45, 46, 53, 54: Performing a “pause” and “resume” function is clearly shown with his transport bar, figure 3a.

It is noted that the applicant has changed “speech” into “audio.” However, dependent claims such as 6, 27, 60 and 62 require “voice” or “speech” which means that the audio must read upon speech. Therefore, this change broadens the claims rather than provides a further limitation.

Claims 51-54: Providing “sections within the screen” is clearly shown by Holm’s variety of windows 36, 38, 40, 42 in figure 1. Each of these windows has a variety of sections within them to allow specific user input to achieve a variety of desired functions.

12. Claims 47, 48 and 50 are rejected under 35 U.S.C. § 103 as being unpatentable over Holm (5,850,629) in view of Simpson ("Mastering WORDPERFECT® 5.1 & 5.2 for Windows") and Dictionary as applied to claim 43 above, in further view of Fawcett (5,802,526).

It is noted that Holm does not explicitly teach displaying images on the screen after text-to speech begins or providing menu navigation prompts as audible signals. However, Holm clearly teaches that selected text may be converted to speech designed for use with any Windows based operating system. Windows based operating systems commonly display a wide variety of information as shown by Holm in figures 1 and 3-6. In column 6, lines 24-30, for example, Holm teaches that it is well known to display a pull-down menu. Fawcett teaches that it is similarly well-known to improve such pull down menus using an Interactive Voice Response System (IVRS), see abstract and column 15, in combination with a word processing program (column 8, lines 59-col. 9).

Claims 47, 48 and 50: The combination of displaying JPEG, MPEG and menu navigation is taught by Fawcett as a desirable combination to improve well-known voice based menu systems that can be frustrating or cumbersome to users causing an unnecessary waste of time (col. 2, lines 37-60). Fawcett teaches that visual data as well as IVR can be combined using well-known HTML in column 15, lines 5-16 where he teaches: HTML information can also contain embedded audio...video (e.g. MPEG encoded video, etc.) and pictures (e.g., JPEG encoded still images, ... to further enhance the IVRU menu information. Therefore, it would have been obvious to further improve a Windows based operating system by allowing pull down menus to be improved by embedded image data in combination with voice data describing the desired commands.

Remarks

13. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the prior art (Holm) clearly suggests combining commonly known text based documents which may include information formatted into pages in combination with real time text-to-speech conversion. Holm explicitly teaches that Word Processors can be used to achieve text manipulation and therefore the combination with any known Word Processor or similar computer software would have been obvious.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Thus, the definition of Word Processor shows that one of ordinary skill in the art would know that this type of software is commonly used to format pages

of books and any resulting patent could not be read upon any electronic book format that could be created from a word processor or similar computer based software.

The arguments of 14 Sep 2007 on pages 5-6 seem repetitious over previous arguments that were already addressed. The applicant has failed to show how the claims differentiate over known displays of word processors that commonly show pages from books and other documents. The applicant's argument that the prior art's use of word processing software cannot select an electronic book from a list of books simply does not make any sense because one of ordinary skill in the art knows that word processors commonly allow users to store more than one document while providing ready access to pick one from a list of documents for display.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The Central fax number is 571-273-8300. Please label INFORMAL” or “DRAFT” communications accordingly.

Mail Stop should be omitted if none is indicated.

Effective 14 January 2005, except correspondence for Maintenance Fees, Deposit Accounts (see 37 CFR 1.25(c)(4)), and Licensing and Review) see 37 CFR 5.1(c) and 5.2(c)), please address correspondence delivered by other delivery services (i.e. – Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

U.S. Patent and Trademark Office
Customer Window, Mail Stop _____
Randolph Building
Alexandria, VA 22314

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (571) 272-7607. The examiner can normally be reached on Monday - Friday from 9:00 a.m.-6:30 p.m. the first week of a bi-week and the second week Mon-Wed 9:00am-6:30 p.m. and 8:00 a.m-4:30 p.m. on the second Thursday.

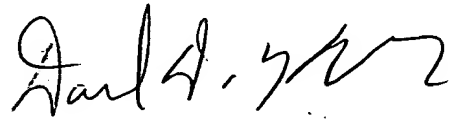
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth, can be reached on (571) 272-7843.

For the Group 2600 receptionist or customer service call (571) 272-2600.

Application/Control Number:
09/344,499
Art Unit: 2626

Page 14

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) between the hours of 6 a.m. and midnight Monday through Friday EST, or by email at ebc@uspto.gov. For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

A handwritten signature in black ink, appearing to read "David D. Knepper", with a stylized flourish at the end.

David D. Knepper
Primary Examiner
Art Unit 2626